

**REMARKS**

After entry of the foregoing amendments, claims 1-12, 16 and 17 are pending in the application. Claims 1-12 have been examined. Claims 13-15 are cancelled, and new claims 16 and 17 are added via this Amendment.

**35 U.S.C. §102:**

*Claims 1, 2, 5-7, 9 and 10*

Claims 1, 2, 5-7, 9 and 10 are rejected under 35 U.S.C. §102(b) as being anticipated by Sullivan (U.S. Patent No. 5,779,561 [hereinafter "Sullivan '561']"). Applicants respectfully traverse this rejection in view of the following remarks.

The present invention is drawn to a novel and unobvious golf ball including features and benefits that are not disclosed, taught or suggested by Sullivan '561. For example, Sullivan '561 does not teach or suggest golf balls having an improved low-temperature performance including rebound (as represented by a slope of a temperature-initial velocity correlation line); flight distance; and durability against consecutive strikes, as shown in the illustrative, non-limiting examples of the present specification.

Moreover, rejections under 35 U.S.C. §102(b) are proper only when each feature recited in the claims is disclosed in the applied art. Sullivan '561 fails to disclose each feature recited in the claims. In particular, to achieve the above objects of the present invention, there is provided a golf ball comprising a portion such as a cover portion (as in claim 1), a core portion (as in new claim 16), and an intermediate portion (as in new claim 17), which are formed of a composition

based on at least one of primary resins selected from one group consisting of an ethylene ionomer resin, polyester elastomer, polyurethane elastomer, polyolefin elastomer, polyamide elastomer, polyolefin resin, and styrene block copolymer which has blended therein at least one of a silicone rubber powder, a silicone resin powder, and a composite powder thereof.

On the other hand, Sullivan '561 discloses an inner cover layer that is blended with at least one part of 20 mesh silicon fillers in coupling agents or silanes resin. Sullivan '561 also discloses that precipitated hydrated silica, silicon carbide platelets, silicon carbide whiskers, and silicates are used in the inner cover layer.

However, the above compounds are inorganic compounds and, thus, differ from the claimed silicone (powder) which is polyorganosiloxane (organic compound) of siloxane polymers based on a structure including alternate silicon and oxygen atoms with various organic radicals attached to the silicon. It is noted that silicon including silicon carbide is different from silicone (polyorganosiloxane). For example, the general formula of the precipitated hydrated silica is  $xH_2O \cdot ySiO_2$ , the general formula of silicon carbide is  $SiC$ , and the general formula of silicates is  $xM_2O \cdot ySiO_2$ , (M represents metal atoms), which are inorganic compounds having low molecular weight. As one skilled in the art would have appreciated, the elements of Sullivan '561 do not disclose the claimed invention.

Accordingly, Applicants respectfully submit that Sullivan '561 fails to disclose each feature recited in the claims, and request that the rejection of claim 1 under 35 U.S.C. §102(b) be withdrawn. The rejection of dependent claims 2, 5-7, 9 and 10 should likewise be withdrawn at least by virtue of these claims depending upon claim 1.

**35 U.S.C. §102(a):**

*Claims 1-3 and 5-12*

Claims 1-3 and 5-12 are rejected under 35 U.S.C. §§102(a) and (e) as being anticipated by Sullivan (U.S. Patent No. 6,204,331 [hereinafter "Sullivan '331']"). Applicants respectfully traverse this rejection in view of the following remarks.

Sullivan '331 also fails to disclose each feature recited in the claims. The Examiner references Table 11 for an alleged disclosure of claimed features. However, according to the present invention, it is noted that the claimed silicone is in a powder form such that the silicone powder is blended and uniformly dispersed in the base resin. In contrast, the ball of Sullivan '331 comprises one or more interior layers comprising one or more silicone compositions, but does not disclose the specific aspects of the claimed cover portion. Moreover, the silicone composition described in Sullivan '331 does not disclose the claimed primary resins selected from one group consisting of an ethylene ionomer resin, polyester elastomer, polyurethane elastomer, polyolefin elastomer, polyamide elastomer, polyolefin resin, and styrene block copolymer.

Also, the fillers described in Table 11 of Sullivan '331 (such as silica and zirconium silicate) are inorganic compounds, which, as noted above, are different from silicone of polyorganosiloxane. Thus, Sullivan '331 does not disclose the claimed silicone in the form of a "powder" that is blended and dispersed uniformly in the recited primary resins.

Accordingly, Applicants respectfully submit that Sullivan '331 fails to disclose the features recited in claim 1, and the rejection under 35 U.S.C. §§102(a) and (e) should be withdrawn. The rejection of dependent claims 2, 3 and 5-12 should also be withdrawn at least by virtue of these claims depending upon claim 1.

**35 U.S.C. §103:**

*Claims 3-4*

Claims 3-4 are rejected under 35 U.S.C. §103(a) as being unpatentable over Sullivan '331 in view of Ueshima et al. (U.S. Patent No. 5,502,095 [hereinafter "Ueshima"]). Applicants respectfully traverse this rejection in view of the following remarks.

The Examiner acknowledges that Sullivan '331 does not disclose expressly the type of silicone in the claimed invention. Thus, the Examiner cites Ueshima for an alleged disclosure of a thermoplastic elastomer composition. However, Applicants respectfully submit such a disclosure in Ueshima fails to make up for the deficient teachings of Sullivan '331 in regard to independent claim 1. Also, Applicants respectfully submit that Ueshima would not have taught such features to one skilled in the art. Accordingly, Applicants respectfully request that the rejection of claims 3 and 4 under 35 U.S.C. §103(a) be withdrawn.

**DOUBLE PATENTING:**

- Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/316,260.
- Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/318,138.
- Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 10/318,010.
- Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/318,261.
- Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/317,985.

Applicants submit the attached Terminal Disclaimer in regard to the respectively applied applications to overcome the double patenting rejections. Accordingly, withdrawal of these rejections is respectfully requested.

**NEW CLAIMS:**

New claims 16-20 are added to obtain more varied protection for the invention. It is submitted that the features of these claims are also not taught or suggested by the applied references.

In view of the preceding amendments and remarks, and the accompanying Terminal Disclaimer, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue that the Examiner feels may be best resolved through a personal or telephonic interview, the Examiner is kindly requested to contact the undersigned attorney at the local telephone number listed below.

The USPTO is directed and authorized to charge all required fees (except the Issue Fee and/or the Publication Fee) to our Deposit Account No. 19-4880. Please also credit any overpayment to said Deposit Account.

Respectfully submitted,



Daniel V. Williams  
Registration No. 45,221

**SUGHRUE MION, PLLC**  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: December 4, 2003